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EXAMINER

KALINOWSKI, A

ART UNIT	PAPER NUMBER
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DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 08/879,070	Applicant(s) Johnson et al
Examiner Alexander Kalinowski	Group Art Unit 2761



Responsive to communication(s) filed on Nov 13, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-10 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

1. Claims 1-10 are presented for examination. Claims 1-10 were originally filed on 6/19/97. On 5/20/99, Applicants filed a request for reconsideration of the grounds of rejection established in the prior office action (Paper No. 6). Applicants further amended claims 1-3 and 8-10 by amendment filed on 11/13/99. After careful consideration of Applicants' arguments and amendments, the Examiner maintains the 35 USC 103 rejection of claims 1-10.

### ***Response to Arguments***

2. Applicant's arguments filed on 11/13/99 have been fully considered but they are not persuasive.

3. With respect to Applicants' arguments directed to newly added limitations to claim 1, Applicants argue on pages 5-6 that the newly added limitations to the final step create a system that "identifies whether such products are on hand, whether they are buildable at all, whether some of the products on hand or buildable are exactly what the customer wants, or whether some are only a close match". The Examiner disagrees. The newly added limitations to claim 1 are directed to a system that identifies one or more available **or** buildable products of a seller from stored inventory information that corresponds exactly **or** most closely to the configured product. According to the claim language in claim 1, a system that identifies one or more available products of a seller from stored inventory information that corresponds exactly to the configured product will meet the scope of this limitation. Alternatively, a system that identifies one or more

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available products of a seller from stored inventory information that corresponds most closely to the configured product will meet the scope of this limitation. The Dworkin reference discloses a system that identifies one or more available products of a seller from the stored inventory information (i.e. for each product or service, the database contains information on price, vendor, specifications, and/or availability) that corresponds most closely to the configured product (see abstract). Therefore, the Dworkin reference reads on the newly added limitation to claim 1 and Applicants' arguments directed to the newly added features are not persuasive.

4. With respect to Applicants' arguments on page 6 directed to the Dworkin reference, applicants' argue that it would be impossible for Dworkin to describe identifying a product that corresponds to the configured product. The Examiner disagrees. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Dworkin discloses a system that searches for products that match or closely match a customer's specification. SFA discloses a system that allows a customer to construct custom products. The Examiner used the combination of Dworkin and SFA references to disclose a system that allows customer both to construct custom products and to search for products that match or closely match a customer's specification. Therefore, Applicants' arguments directed to the Dworkin reference is not persuasive.

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5. With respect to Applicants' arguments on page 6 directed to the SFA reference, Applicants argue that the SFA reference does not disclose a system that identifies products that are available or buildable nor does SFA disclose identifying products that exactly or most closely correspond to the configured product. The Examiner disagrees. The Examiner did not rely on SFA to disclose these features but instead relied on the Dworkin reference to disclose these features. Furthermore, the Examiner relied on the combination of Dworkin and SFA to disclose these limitations of claim 1. Therefore, Applicants' arguments directed to the SFA reference are not persuasive.

6. With respect to Applicants' arguments on page 7 directed to claim 2, Applicants argue that Dworkin does not make a distinction between what is available, what is buildable, and what is neither. The Examiner disagrees. The newly added feature of claim 2 is directed to a system that identifies one or more available and buildable products in inventory which most closely correspond to the configured product. Dworkin discloses identifying from the inventory of the selling entity, using the stored inventory information, one or more immediately available and buildable products which most closely correspond to the configured product; see Fig. 7, column 6, lines 11 through 15 and column 7, lines 54 through 61. If a product is listed as available in inventory, it is also buildable. The Examiner notes that there is no limitation in claim 2 directed to what is available, what is buildable, and what is neither. Therefore, Applicants' arguments are not persuasive.

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7. With respect to Applicants' arguments directed to claims 8-10, the newly added limitations to claims 8-10 are similar to the newly added limitations in claims 1 and 2 and the Examiner refers Applicants to the rejection of claims 8-10 in the 35 USC 103 section below and to the discussion directed to claim 1.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin Pat. No. 4,992,940, (hereinafter Dworkin) in view of "Sales-force automation comes of age.(includes related articles on how Hewlett-Packard Co. Computer Systems Group implemented technology-enabled selling applications)(hereinafter SFA).

a. With respect to claim 1, Dworkin discloses

A computer system implemented method for facilitating a sale of a product from an inventory of a selling entity, the computer system including a memory arrangement and at least one processing unit coupled to the memory arrangement; column 3, lines 48 through 64; the method comprising the steps of:

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storing in the memory arrangement product inventory information related to the inventory of the selling entity; column 3, lines 60 through 66 and column 7, lines 54 through 61;

obtaining information regarding a customer's needs related to the selling entity products; column 5, lines 43 through 68; and

identifying from the inventory of the selling entity, using the stored inventory information, one or more available products which most closely correspond to the configured product; see Fig. 7, column 6, lines 11 through 15 and column 7, lines 54 through 61.

Dworkin does not explicitly disclose

storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity; and

interactively selecting product options to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options.

However, SFA discloses an automated system (i.e. GM PROSPEC) to configure products to suit buyers' needs (see abstract and page 1). SFA discloses storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity (i.e. online marketing encyclopedia) (page 3, lines 4-6 and lines 18-23). Furthermore, SFA discloses presenting product options to a user of the computer system for selection by the user to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options (i.e. product configurator) (page 3, lines

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7-11 and lines 24-29). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity and presenting product options to a user of the computer system for selection by the user to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options as disclosed by SFA within the system disclosed by Dworkin in order to permit salespeople to configure products to suit the buyers' needs in an efficient manner and maximize the salesperson's time with the customer thereby increasing profitability (abstract and page 1, line 43 - page 2, line 4).

b. With respect to claim 2, Dworkin does not explicitly disclose a method as recited in claim 1, further comprising ranking the selected product options according to a value of the product options to the customer and, using the ranking to identify available and buildable products in inventory corresponding to the configured product.

However, Dworkin does reveal accepting desired specifications from a user in a variety of ways, not all of which are disclosed in the patent. Column 5, lines 55 through 68. It was well known in the art at the time to rank the relative importance of options or attributes to customers. It would have been obvious to one of ordinary skill in the art at the time to allow the user of a combined Dworkin/SFA system, as discussed above in connection with claim 1, to rank the

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relative importance of various options of a custom configured system to him and to identify products meeting the highest ranked requirements.

c. With respect to claim 8, Dworkin discloses

a computer system implemented method for facilitating a sale of a product from an inventory of a selling entity, the computer system including a memory arrangement and at least one processing unit coupled to the memory arrangement; column 3, lines 48 through 64; the method comprising the steps of:

storing in the memory arrangement product inventory information related to the inventory of the selling entity; column 3, lines 60 through 66 and column 7, lines 54 through 61; and obtaining information regarding a customer's needs related to the selling entity products; column 5, lines 43 through 68.

Dworkin does not explicitly disclose

storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity and

However, SFA discloses an automated system (i.e. GM PROSPEC) to configure products to suit buyers' needs (see abstract and page 1). SFA discloses storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity (i.e. online marketing encyclopedia) (page 3, lines 4-6 and lines 18-23).

Dworkin and SFA do not explicitly disclose

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interactively selecting product options to define a sellable product which satisfies the customer's needs using the stored configuration rules and the stored product inventory information to constrain selection of the product options to product options available in the available inventory of the selling entity.

However, Dworkin discloses identifying from the inventory of the selling entity, using the stored inventory information, one or more available products which most closely correspond to the configured product; see Fig. 7, column 6, lines 11 through 15 and column 7, lines 54 through 61. SFA discloses interactively selecting product options to define a sellable product which satisfies the customer's needs using the stored configuration rules to constrain selection of the product options to product options available (i.e. virtually eliminated the factory reject rate) in the available inventory of the selling entity (page 1, lines 22-40, page 3, lines 7-11 and lines 18-29). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include presenting product options to a user of the computer system for selection by the user to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options to product options in the as disclosed by SFA within the Dworkin system in order to permit salespeople to configure products to suit the buyers' needs in an efficient manner (i.e. present custom products that can be built by the seller) and maximize the salesperson's time with the customer thereby increasing profitability (abstract and page 1, line 43 - page 2, line 4).

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d. With respect to claim 9, Dworkin discloses

a computer system implemented method for facilitating a sale of a product from an inventory of a selling entity, the computer system including a memory arrangement and at least one processing unit coupled to the memory arrangement; column 3, lines 48 through 64; the method comprising the steps of:

storing in the memory arrangement product inventory information related to the inventory of the selling entity; column 3, lines 60 through 66 and column 7, lines 54 through 61;

obtaining information regarding a customer's needs related to the selling entity products; column 5, lines 43 through 68; and

providing an indication to the user of the computer system, based on the stored inventory information, of whether selection of a particular presented product option, if incorporated into the configured product, would preclude obtaining the product from the inventory of the selling entity(i.e. product availability); see Fig. 7, column 6, lines 11 through 15 and column 7, lines 54-61.

Dworkin does not explicitly disclose

storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity; and

presenting product options to a user of the computer system for selection by the user to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options.

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However, SFA discloses an automated system (i.e. GM PROSPEC) to configure products to suit buyers' needs( see abstract and page 1). SFA discloses storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity (i.e. online marketing encyclopedia) (page 3, lines 4-6 and lines 18-23). Furthermore, SFA discloses presenting product options to a user of the computer system for selection by the user to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options (i.e. product configurator) (page 3, lines 7-11 and lines 24-29). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity and presenting product options to a user of the computer system for selection by the user to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options as disclosed by SFA within the system disclosed by Dworkin in order to permit salespeople to configure products to suit the buyers' needs in an efficient manner and maximize the salesperson's time with the customer thereby increasing profitability (abstract and page 1, line 43 - page 2, line 4).

e. With respect to claim 10, Dworkin discloses a computer system implemented method for facilitating a sale of a product from an inventory of a selling entity, the computer system including a memory arrangement and at least

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one processing unit coupled to the memory arrangement; column 3, lines 48 through 64; the method comprising the steps of:

storing in the memory arrangement product inventory information related to the inventory of the selling entity; column 3, lines 60 through 66 and column 7, lines 54 through 61.

Dworkin does not explicitly disclose

storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity; column 5, lines 52 through 62.

However, SFA discloses storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity (i.e. online marketing encyclopedia) (page 3, lines 4-6 and lines 18-23). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity as disclosed by SFA within the system disclosed by Dworkin in order to permit salespeople to configure products to suit the buyers' needs in an efficient manner and maximize the salesperson's time with the customer thereby increasing profitability (abstract and page 1, line 43 - page 2, line 4).

Neither Dworkin nor SFA explicitly discloses

obtaining information regarding a customer's intended uses of a product to be purchased; assigning a corresponding value to each of the customer's uses depending on an importance of the use to the customer; and

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identifying, using the stored inventory information and the obtained information regarding the customer's intended uses and corresponding value, one or more products which are in the available inventory of the selling entity and which most closely satisfy the customer's intended use of the product.

However, Dworkin discloses obtaining information regarding a customer's need in terms of minimum specifications of a product, column 5, lines 43 through 68. It was well known in the art at the time to gather minimum specifications by asking questions regarding intended use, in lieu of asking questions regarding technical specifications, particularly in the case of a less sophisticated customer (e.g., asking the customer whether a printer was to be used as a high capacity printer for business purposes or as a low capacity printer for home purposes in lieu of asking whether a laser or ink jet printer was desired).

It was well known in the art at the time to assign a value to each factor or feature of a configuration depending on the importance of the factor or feature to the customer. It would have been obvious to one of ordinary skill in the art at the time to assign such a value to each intended use when soliciting requirements in the form of intended uses so as to be able to determine the most important requirements of the customer.

Dworkin discloses using a set of specifications to identify products available in inventory. Column 6, lines 11 through 15. Once the most important specifications or features had been identified as described in the preceding paragraphs, it would have been obvious to one of ordinary skill in the art at the time to use those specifications to identify products available in inventory

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because otherwise gathering the specifications would have been pointless. It would further have been obvious to one of ordinary skill in the art at the time to rank the identified products based on the degree to which each corresponded to the customer's highest ranked intended uses of the product because doing so would allow a less technically sophisticated customer to select the most useful product without understanding the relative importance of all of the product configuration options.

10. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin and SFA as applied to claim 1 above, and further in view of Lynch et al, Pat. No. 5,708,798 (hereinafter Lynch).

a. With respect to claim 3, Dworkin and SFA do not explicitly disclose a method as recited in claim 1, wherein the stored configuration information comprises a plurality of configuration rules which define relationships between two of more product options. However, Lynch discloses a computer based system that configures computer systems (see abstract). Lynch discloses configuring the system based on constraint rules that identify relationships between product options (col. 10, lines 11-27). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a method as recited in claim 1, wherein the stored configuration information comprises a plurality of configuration rules which

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define relationships between two or more product options within the Dworkin/SFA combination in order ease the burden of configuring complex customized systems (col. 1, lines 25-28).

b. With respect to claim 4, Dworkin and SFA do not explicitly disclose a method as recited in claim 3, wherein the configuration rules comprises a plurality of logic rules.

However, Lynch discloses a method as recited in claim 3, wherein the configuration rules comprises a plurality of logic rules (col. 10, lines 11-27). Combining Dworkin/SFA with Lynch would yield a product that would allow customers both to construct custom products, as in SFA and Lynch, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a method as recited in claim 3, wherein the configuration rules comprises a plurality of logic rules within the Dworkin/SFA combination in order ease the burden of configuring complex customized systems (col. 1, lines 25-28).

c. With respect to claim 5, Dworkin and SFA do not explicitly disclose A method as recited in claim 3, wherein the configuration rules comprise constraint rules which define engineering relationships between product options.

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However, Lynch discloses a method as recited in claim 3, wherein the configuration rules comprise constraint rules which define engineering relationships between product options (col. 10, lines 11-27). Combining Dworkin/SFA with Lynch would yield a product that would allow customers both to construct custom products, as in SFA and Lynch, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill a method as recited in claim 3, wherein the configuration rules comprise constraint rules which define engineering relationships between product options in the art at the time of Applicant's invention to include within the Dworkin/SFA combination in order ease the burden of configuring complex customized systems (col. 1, lines 25-28).

d. With respect to claim 6, Dworkin and SFA do not explicitly disclose a method as recited in claim 3, wherein the configuration rules comprise resource rules which define relationships between product options in terms of resources used and resources required.

However, Lynch discloses a method as recited in claim 3, wherein the configuration rules comprise resource rules which define relationships between product options in terms of resources used and resources required (col. 10, lines 11-27). Combining Dworkin/SFA with Lynch would yield a product that would allow customers both to construct custom products, as in SFA and Lynch, and to search for products matching or almost matching their specifications, with a view

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to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a method as recited in claim 3, wherein the configuration rules comprise resource rules which define relationships between product options in terms of resources used and resources required within the Dworkin/SFA combination in order ease the burden of configuring complex customized systems (col. 1, lines 25-28).

e. With respect to claim 7, Dworkin and SFA do not explicitly disclose a method as recited in claim 3, wherein the configuration rules comprise cross-reference rules which define relationships between similar product options .

However, Lynch discloses a method as recited in claim 3, wherein the configuration rules comprise cross-reference rules which define relationships between similar product options (col. 10, lines 11-27 and col. 13, lines 33-57).Combining Dworkin/SFA with Lynch would yield a product that would allow customers both to construct custom products, as in SFA and Lynch, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a method as recited in claim 3, wherein the configuration rules comprise cross-reference rules which define relationships between similar product options within the Dworkin/SFA combination in order ease the burden of configuring complex customized systems (col. 1, lines 25-28).

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***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 8:30 AM to 6:00 PM. In addition, the examiner can be reached on alternate Fridays.

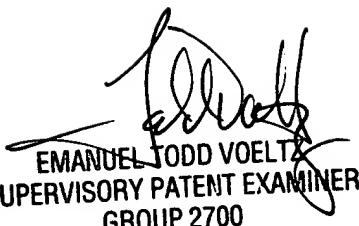
If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Emanuel Todd Voeltz, can be reached on (703) 305-9714. The fax telephone number for this group is (703) 305-0040.

Alexander Kalinowski

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1/14/00

*dt*



EMANUEL TODD VOELTZ  
SUPERVISORY PATENT EXAMINER  
GROUP 2700